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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,861	07/09/2003	Thomas G. Ranney	5051.637	'1369
20792	7590	03/24/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			BELL, KENT L	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	10/615,861	
Examiner	RANNEY ET AL.	
Kent L. Bell	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

application filed 7/9/03

1) Responsive to communication(s) filed on 7/9/03.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 7/9/03 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

Detailed Action

Objection to the Disclosure

37 CFR 1.163

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

Detailed Action

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. Page 1, line 10, Applicants set forth a Genus for the instant plant but does not set forth a species. Applicants should set forth in the specification the instant plant's species designation, to the extent known. It appears the instant plant's Genus and species should be - - *Calycanthus (chinensis x floridus)* x *Calycanthus (chinensis x occidentalis)*- - as set forth on page 3, lines 10 and 11 and in Figure 4. If such is accurate, this information should be set forth at the location stated above.

Detailed Action

B. Page 3, lines 6-16, Applicants set forth a Genus and species for each parental cultivar.

However, applicants have not stated whether the parental cultivars are named or unnamed.

Applicants set forth a cross in figure 4 and set forth cultivar designations. It appears that 'H2000-14-001' and 'H2000-017-002' may be the parental cultivars. If accurate, such should be inserted into the specification. Further, applicants should specify which is the female and which is the male parent.

C. Page 3, lines 10 and 11, Applicants are requested to set forth in the specification whether the parental cultivars and cultivar, 'Athens', has been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the cultivar name.

D. Page 3, lines 15, 16, and 19-21, Applicant should delete "the North Carolina State University, Mountain Horticultural Crops Research Station," as this recitation constitutes unwarranted advertising (MPEP 1610). The current recitation without the recitation stated above is more than adequate.

Detailed Action

E. Page 3, line 31, page 6, lines 27 and 30, page 7, lines 6, 13, 14, page 9, Table 1, lines 5, 10, and 17, and page 11, line 8, Applicant states “tepals” and “Tepal”. It appears - -petals- - or - -Petal- - may be the more botanically correct term to use for this characteristic. Applicant should verify the term used for this characteristic and set forth the more appropriate term in the specification. Correction and/or clarification is necessary.

F. Page 5, lines 12-15, Applicants state “original” plant is 75 cm tall then state “‘Venus’ is anticipated to be...”. The original plant and ‘Venus’ should be the same plant. The recitations set forth cause confusion as it leads one to believe the original plant and ‘Venus’ are two different plants. Correction and/or clarification is necessary.

G. Applicants should set forth in the specification additional information relative to the instant plant including the typical and observed plant shape.

H. Page 5, lines 21-23, Applicants should set forth in the specification additional information relative to the instant plant’s shoots including the typical and observed shoot length, diameter, and internode length.

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I. Applicants should set forth in the specification information relative to the instant plant's trunk and branches including the typical and observed trunk diameter at a specified height above the soil and branch length and diameter.

J. Page 6, lines 15 and 16, Applicants should insert into the specification additional information relative to the instant plant's petioles including the typical and observed petiole diameter and coloration with reference to the employed color chart.

K. Page 6, lines 23 and 24, Applicants set forth fall foliage color however, it is unclear whether the colorations set forth are for the upper, lower, or both surfaces. Applicants should set forth in the specification color designations for the upper and lower leaf surfaces.

L. Page 7, line 11, Applicants should set forth in the specification additional information relative to the instant plant's flower including the typical and observed flower depth.

M. Page 7, lines 13-16, Applicants state "Outer" and "Inner". It is unclear if applicants meant to state - -upper- - and - -lower- - or actually meant outer and inner. It doesn't appear applicants meant outer and inner since applicants have previously stated the petals are in one

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imbricate series, page 6, line 27. Correction and or clarification is necessary. Applicants should set forth in the specification a color designation for the upper and lower petal surfaces.

N. Page 7, line 18, Rather than stating "Bracts". It appears - -Sepals- - may be the more appropriate botanical term to use to describe this characteristic. Applicants should verify the appropriate botanical term for this characteristic and set it forth in the specification. Additionally, applicants should set forth in the specification additional information relative to the instant plant's bracts (sepals) including the typical and observed bract (sepal) shape, length, width, apex, margin, and base descriptors and coloration (both surfaces) with reference to the employed color chart.

O. Page 7, line 25, Applicants should set forth in the specification the lastingness of the bloom, on the plant.

P. Applicants should set forth in the specification information relative to the instant plant's peduncle including the typical and observed peduncle length, diameter, and coloration with reference to the employed color chart.

Q. Applicants should set forth in the specification information relative to the instant plant's Disease Resistance/Susceptibility.

Detailed Action

R. Page 8, lines 8-24, Applicants state “parental species” and “*C. chinensis* parent”. Applicant has previously set forth the parental cultivars, page 3, lines 10 and 11 and Figure 4. The recitations above are contradictory. Correction and/or clarification is necessary.

S. Page 9, line 2, Applicants state “**Comparison with Parental Types**”. This recitation does not appear accurate. It appears applicants have set forth a brief comparison between the instant plant and plants of specific species. It appears the more proper recitation would be “Comparison with a typical plant from three different Calycanthus species”. Correction and/or clarification is necessary.

T. Applicants should set forth in the specification a brief comparison between the instant plant and its parental cultivars, such not need be in any great detail but should at least distinguish the plants from each other. Applicants have only set forth a comparison between the instant plant and plants of specific species not the parental cultivars.

U. Applicants should provide information relative to the instant plant’s reproductive organs including pistil number, anthers, stigma, styles, ovary/ies, (such as quantity, size and coloration of organs) into the specification with reference to the color chart employed (if

Detailed Action

available). If pollen is produced, such should be accounted for in general terms relative to the quantity and in coloration by way of reference to the color chart employed.

V. Page 10, The Claim, Applicants should insert - -plant- - after "*Calycanthus*" as The Claim must be directed to "the plant" (37 CFR 1.164, MPEP 1605).

W. Applicants set forth throughout the specification color designations such as (144 A-B), page 5, line 21. It is not clear whether these recitations mean both colorations are present, i.e. 144 A and 144 B, or a mixture of the two colorations or a color in between the two. Correction and/or clarification is necessary.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

Claim Rejection

35 U.S.C. 112, 1st & 2nd Paragraphs

Detailed Action

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

Comments

Applicants should note the new amendment format which is now mandatory (Web site stated below).

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognitice/revamdtprac.htm>

Applicants should send all correspondence to the following address:

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (571) 272-0974.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL
PRIMARY EXAMINER**

Kent J. Bell